

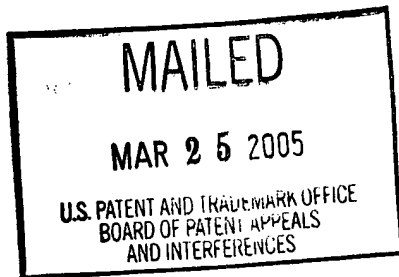
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAY S. WALKER, ANDREW S. VAN LUCHENE, DEIRDRE O'SHEA and DEAN
ALDERUCCI



Appeal No. 2005-0385
Application No. 09/260,437

HEARD: MARCH 9, 2005

Before MCQUADE, NASE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1-34 and 70-72, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method and apparatus for facilitating the sale of subscriptions to periodicals. Claim 1 is representative of the invention and reads as follows:

1. A method, comprising:

receiving a signal that indicates at least one item;

ascertaining whether the at least one item is associated with an offer for a rebate;

generating a code if the at least one item is associated with an offer for a rebate;

outputting a signal that represents the code;
outputting an offer for a rebate in exchange for establishing a subscription to a periodical, in which the subscription to the periodical is not the at least one item; and

charging an item price.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Johnsen	5,250,789	Oct. 5, 1993
Flaten	5,467,269	Nov. 14, 1995
Von Kohorn	5,759,101	Jun. 2, 1998
Gottlich et al. (Gottlich)	6,024,288	Feb. 15, 2000
		(filed Dec. 24, 1997)

Horton, "Holiday gift subs up, some due to novel promotions, " 21 Folio: the Magazine for Magazine Management, no. 2, 39 (February 1992).¹

The following rejections are before us on appeal.

Claims 1-4, 10-34 and 70-72 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnsen in view of Gottlich and Horton.

Claims 5-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnsen in view of Gottlich, Horton and Von Kohorn.

Claims 5-9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnsen in view of Gottlich, Horton and Flaten.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 24) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 23 and 26) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

¹ The examiner and appellants have referred to this article as "Folio" in the answer and briefs.

The combined teachings of Johnsen and Gottlich are fairly suggestive of a method of scanning a product at checkout, searching a database to ascertain whether the product scanned is associated with a rebate offer or coupon for either that item or a related item and, if an association is found, either applying the rebate or coupon instantly at checkout or printing out a rebate offer or coupon for subsequent use, and charging a price for the item scanned, as well as the apparatus and computer readable medium for use in performing such method. Johnsen and Gottlich do not specifically teach anything with regard to subscriptions to periodicals, much less outputting an offer for a rebate in exchange for establishing a subscription to a periodical. Horton evidences that it was known in the art at the time of appellants' invention for a magazine to distribute 10-issue gift certificates for sale to retail establishments that are redeemable at retail establishments such as newsstands and for a magazine subscriber service to put prepaid subscription-order forms and gift cards for participating magazines into packages distributed to retail stores.

Appellants argue, and we agree, that the applied references do not teach or suggest outputting an offer for a rebate in exchange for establishing a subscription to a periodical, as called for in each of appellants' independent claims 1 and 70-72. Horton, in evidencing that the sale of gift certificates for cards for periodicals or subscriptions to periodicals in retail establishments was known at the time of appellants' invention, may have provided suggestion to treat such gift certificates in the same manner as the

products discussed by Johnsen and Gottlich by, for example, outputting a rebate offer or coupon for such gift certificate or card upon scanning another product associated with such offer or coupon at checkout or scanning the gift certificate or gift card at checkout and outputting a rebate offer or coupon for a related product. Horton does not teach or suggest offering a rebate, or anything else, in exchange for establishing a subscription to a periodical.

For the foregoing reasons, we conclude that the combined teachings of Johnsen, Gottlich and Horton are insufficient to establish a prima facie case that the subject matter of independent claims 1 and 70-72, or claims 2-4 and 10-34 depending from claim 1, would have been obvious. We thus cannot sustain the examiner's rejection of these claims.

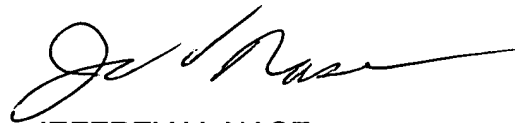
The examiner's application of the additional teachings of Von Kohorn and Flaten provides no cure for the above-noted deficiency in the combination of Johnsen, Gottlich and Horton. It follows that we also cannot sustain the examiner's rejection of claims 5-9 as being unpatentable over Johnsen in view of Gottlich, Horton and Von Kohorn or as being unpatentable over Johnsen in view of Gottlich, Horton and Flaten.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-34 and 70-72 under 35 U.S.C. § 103 is reversed.

REVERSED


JOHN P. MCQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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